

REMARKS

Reconsideration and allowance of amended Claims 1-5 and 7-14 and allowance of new Claims 19-23 as presented herein are respectfully requested.

The Examiner has rejected Claims 1-5 and 7-14 under 35 U.S.C. §102(b) for anticipation by Jiang et al. U.S. Patent No. 6,442,287 ("Jiang et al.").

A close study of Jiang et al. will show that this patent fails to disclose each and every step and limitation in the amended claims.

Claims 1-5 and 7-14 have been amended to make it clear that at least two of the three tests recited therein are carried out on each bone in a population of cancellous bone (trabecular bone), i.e., each cancellous bone is subjected to at least two of a compression test, an apparent density test and an appearance test. The claims as amended *exclude* a procedure wherein a test, e.g., a density test, is carried out on a cancellous bone specimen after which the specimen is subdivided into portions before conducting a different test on one of the subdivided portions. Such a procedure corresponds to the procedure disclosed in Jiang et al. Thus, in Jiang et al., femoral neck specimens were subjected to a density test (column 7, lines 53-60) after which the specimens were cut into cubes for compressive strength testing employing an Instron 8500 materials testing system (column 8, line 44 to column 9, line 13).

In addition to this fundamental difference between the method of amended Claims 1-5 and 7-14, it is also noted that in contrast to applicant's *manual* compression test, the only test disclosed in Jiang et al. for measuring compressive strength of a cancellous bone specimen employs a *machine*, namely, the aforementioned Instron 8500 materials testing

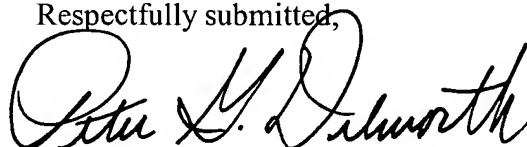
system. As pointed out by applicant at page 2, lines 8-12 of the specification, testing compressive strength of a specimen of donor bone employing machinery is impracticable since (1) the test results in the destruction of the bone specimen (as, indeed, noted by Jiang et al. at column 9, lines 8-12) and (2) the test is not determinative of the compressive strength of cancellous bone from a different, or even the same, donor.

In view of the foregoing, amended Claims 1-5 and 7-14 are believed to define patentable invention over Jiang et al.

The Examiner has indicated the allowability of Claims 6 and 15-18 if rewritten in independent form including all of the limitations of the base claims and any intervening claim. Applicant has cancelled Claims 6 and 15-18 substantially re-presenting these claims as new Claims 19-22 which comply with the Examiner's directives for allowance.

Reconsideration and allowance by the Examiner of amended Claims 1-5 and 7-14 and allowance of new Claims 19-22 are once again respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter G. Dilworth", is written over the typed name.

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